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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,427	07/26/2001	Bradford H. Needham	P 279172 P11167	4273

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EXAMINER

LEZAK, ARRIENNE M

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,427

Applicant(s)

NEEDHAM ET AL.

Examiner

Arrienne M. Lezak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9 November 2005 has been entered.

Examiner notes that Claims 1-3, 11-13 & 19-21 have been amended, no Claims have been cancelled and no Claims have been added. Claims not explicitly addressed herein are found to be addressed within prior Office Action dated 16 May 2005 as reiterated herein below.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over extensive consideration of US Patent 5,760,917 to Sheridan in view of US Patent US 6,611,613 B1 to Kang.

3. Regarding Claims 1, 11, 19, 29 & 31, Sheridan discloses a method, system and computer program for image sharing, (Abstract), comprising:

- determining identifying information for an image, (Col. 6, lines 56-6; Col. 7, lines 1-51; Col. 10, lines 9-67; & Col. 11, lines 1-59);
- defining a sharing rule that specifies with which one or more recipients images are shared, the sharing rule based on identifying information, (Col. 5, lines 7-18); and
- applying identifying information associated with the image to the sharing rule to determine the one or more recipients with which the image should be shared, (Col. 5, lines 19-42; Col. 10, lines 61-67 & Col. 11, lines 1-59), making the same available to said recipients, (Col. 4, lines 25-67 & Col. 5, lines 1-45).

4. Though Sheridan discloses indexing and sharing digital images associated with identification information entered by the user, Sheridan does not specifically enumerate the use of face recognition technology wherein said identifying information is for at least one face in the image. Kang discloses face recognition technology, which technology includes means for image analysis to determine face and association of face identification information to the image corresponding to the determined face, (Kang - Abstract; Col. 2, lines 46-67; Col. 3, lines 1-34, 61-67; & Col. 4, lines 1-22). It would

have been obvious to one of ordinary skill in the art at the time of invention by Applicant to incorporate the use of face recognition technology into the Sheridan image distribution/indexing, (Sheridan – Col. 11, lines 9-12), method and system as noted within Kang, which enumerates the fact that image indexing is one field, which highly regards face recognition technology, (Kang - Col. 1, lines 26-30). Thus, Claims 1, 11, 19, 29 & 31 are found to be unpatentable in light of the combined teachings of Sheridan in view of Kang.

5. Regarding Claims 2, 6, 12, 16, 20 & 24, the combined teachings of Sheridan and Kang are relied upon as noted herein. Sheridan in view of Kang further discloses a method, system and computer program for image sharing comprising: determining the (face) identifying information/data (for at least on face) in the image using a (face) recognition/conversion technique, (Sheridan - Col. 5, lines 7-45), in conjunction with a database of (face) information, (Sheridan - Abstract; Col. 2, lines 20-67; Col. 3, lines 1-15; Col. 4, lines 25-61; Col. 10, lines 61-67; & Col. 11, lines 1-59). Examiner notes that indexing digital image information using face recognition technology obviously reads upon identification information stored in a database of image information. Thus, Claims 2, 6, 12, 16, 20 & 24 are found to be unpatentable in light of the combined teachings of Sheridan in view of Kang.

6. Regarding Claims 3, 13 & 21, the combined teachings of Sheridan and Kang are relied upon as noted herein. Sheridan in view of Kang further discloses a method, system and computer program for image sharing comprising: determining the (face) identifying information associated with the image by a user identifying a (face) in the

image, (Sheridan - Col. 5, lines 34-42). Thus, Claims 3, 13 & 21 are found to be unpatentable in light of the combined teachings of Sheridan in view of Kang.

7. Regarding Claims 4, 14 & 22, the combined teachings of Sheridan and Kang are relied upon as noted herein. Sheridan in view of Kang further discloses a method, system and computer program for image sharing comprising: automatically making the image available to the determined one or more recipients, (Sheridan - Col. 5, lines 7-64). Thus, Claims 4, 14 & 22 are found to be unpatentable in light of the combined teachings of Sheridan in view of Kang.

8. Regarding Claims 5, 15 & 23, the combined teachings of Sheridan and Kang are relied upon as noted herein. Sheridan in view of Kang further discloses a method, system and computer program for image sharing wherein making the image available comprises at least one of automatically sending a copy of the image to the determined one or more recipients by email and automatically sending a link to the image on a Web site to the determined one or more recipients, (Sheridan - Col. 5, lines 7-64). Thus, Claims 5, 15 & 23 are found to be unpatentable in light of the combined teachings of Sheridan in view of Kang.

9. Regarding Claims 7, 17, 25, 30 & 32, the combined teachings of Sheridan and Kang are relied upon as noted herein. Sheridan in view of Kang further discloses a method, system and computer program for image sharing wherein the image comprises at least one of a digital photo and a digital video, (Sheridan - Col. 4, lines 3-47). Examiner notes that digital video would be obvious in light of the teaching of digital images generally as a digital video is comprised of a series of digital images. Thus,

Claims 7, 17, 25, 30 & 32 are found to be unpatentable in light of the combined teachings of Sheridan in view of Kang.

10. Regarding Claims 8, 18 & 26, the combined teachings of Sheridan and Kang are relied upon as noted herein. Sheridan in view of Kang further discloses a method, system and computer program for image sharing wherein the sharing rule specifies at least one of a set of (face) identifying information, a range of (face) identifying information and a characteristics of an item or set of (face) identifying information, (Sheridan - Col. 10, lines 30-67 & Col. 11, lines 1-22). Thus, Claims 8, 18 & 26 are found to be unpatentable in light of the combined teachings of Sheridan in view of Kang.

11. Regarding Claims 9 & 27, the combined teachings of Sheridan and Kang are relied upon as noted herein. Sheridan in view of Kang further discloses a method, system and computer program for image sharing wherein the sharing rule comprises a rule that images are only to be shared with the one or more recipients that are on a (buddy) list, (Sheridan - Col. 4, lines 48-67; Col. 5; and Col. 6, lines 1-24). Examiner notes that Sheridan teaches a stored list of individuals with whom the user has chosen to share images. Further, said list would obviously include friends or "buddies" of the user, and as such, could obviously be referred to as a "buddy list". Thus, Claims 9 & 27 are found to be unpatentable in light of the combined teachings of Sheridan in view of Kang.

12. Regarding Claims 10 & 28, the combined teachings of Sheridan and Kang are relied upon as noted herein. Sheridan in view of Kang further discloses a method, system and computer program for image sharing wherein the (face) identifying

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information (comprises a personal name of a person whose face) is in the image, (Sheridan - Col. 10, lines 30-67 & Col. 11, lines 1-22). Examiner notes that the use of personal names, (predetermined characteristic), corresponding to individuals within the photos would have been obvious in light of the indexing/storage functionality within Sheridan wherein the user chooses individuals within images by name, for storing, indexing or sharing purposes. Thus, Claims 10 & 28 are found to be unpatentable in light of the combined teachings of Sheridan in view of Kang.

Response to Arguments

13. Applicant's arguments filed 9 November 2005, have been fully considered but they are not persuasive. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

14. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as clearly noted

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above, Kang provides proper motivation to combine the references by clearly noting, "a technique for detecting faces and facial area is highly regarded in various applied fields such as...image indexing," (Kang – Col. 1, lines 17-32), which image indexing is clearly taught by Sheridan, (Sheridan – Col. 11, lines 9-12), as noted herein.

15. In response to applicant's argument that Sheridan is directed to an image distribution method rather than an image indexing scheme, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Moreover, Examiner again notes that Sheridan clearly teaches image indexing, (Col. 11, lines 9-12).

16. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, again as clearly noted above, Kang provides proper motivation to combine the references by clearly noting, "a technique for detecting faces and facial area is highly regarded in various applied fields such as...image indexing," (Kang – Col.

1, lines 17-32), which image indexing is clearly taught by Sheridan, (Sheridan – Col. 11, lines 9-12), as noted herein.

17. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Specifically, Applicant argues that the prior art does not suggest the use of face identifying information as applied to a sharing rule to determine which recipients should receive the image, and Examiner respectfully disagrees. As noted herein above, the combination of the references clearly reads upon Applicant's claim language in its entirety.

18. Sheridan clearly teaches an (image) sharing rule comprising identification information, and Kang clearly teaches face recognition technology, wherein both references teach motivation to combine, (image indexing, storage and distribution), and wherein the combined teachings clearly and obviously would encompass determination of face identifying information for faces in an image for purposes of image distribution. Further, Applicant concedes that "Kang teaches an apparatus for detecting the position of a human face in an input image", (RCE dated 9 November 2005, p.10), wherein Examiner finds that the position of a human face is obviously face identifying information. Additionally, Examiner notes that proof of enablement is not a requirement under 35 USC § 103(a); however, Examiner further notes the fact that both Sheridan

and Kang have been patented, proving enablement of the same, such that one of ordinary skill in the art would know how to enable the combination of the two references.

19. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., face identifying information comprising identification numbers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Moreover, Examiner notes that Sheridan teaches the use of "predetermined characteristics" for indexing purposes, which predetermined characteristics may be any suitable predetermined characteristics determined by the system operator, (Sheridan – Col. 11, lines 3-12), wherein, in light of the Kang face recognition technology as used within image indexing, it would have been obvious for said predetermined characteristics to include personal names, identification numbers or any other face identifying information, as noted herein.

20. Thus, as Examiner has completely addressed Applicant's amendment, and finding Applicant's arguments do not show how the amendments and reconsideration of the same avoids such references or objections, Examiner hereby maintains the rejection of all original and amended claims in their entirety.

Double Patenting

21. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

22. Claim 1-32 are rejected on the ground of nonstatutory double patenting over claims 1-5 of U. S. Patent No. US 6,606,398 B2 to Cooper since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: determining, indexing/cataloging and storing face identifying information as derived from image data for purposes of creating a database of said face identifying information, which database includes other identification information such as names of individuals within said images.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

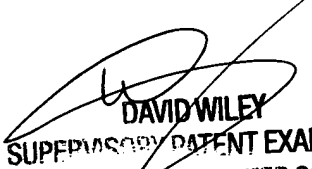
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arrienne M. Lezak whose telephone number is (571)-272-3916. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571)-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arrienne M. Lezak
Examiner
Art Unit 2143

AML


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